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10/766,032	01/29/2004	Alastair Michael Slater	1509-481	2436

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EXAMINER

WALTER, CRAIG E

ART UNIT	PAPER NUMBER
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2188

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/766,032	Applicant(s) SLATER ET AL.	
	Examiner Craig E. Walter	Art Unit 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 11-53, 60-64 and 66-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 54-59, 65 and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-10, 54-59, 65 and 69 are pending in the Application.

Claims 11-53, 60-64 and 66-68 are withdrawn.

Of the pending claims, claims 1, 8, 9, 55, 57, 58, 65 and 69 are amended.

Of the pending claims, claims 1-10, 54-59, 65 and 69 presently stand rejected.

Election/Restrictions

2. Applicant's election with traverse of Invention I (1-10, 54-59, 65 and 69) in the reply filed on 24 October 2006 is acknowledged. The traversal is on the ground(s) that Inventions I and II are not related as subcombinations usable in a single combination, and likewise that Examiner failed to establish that Invention II has separate utility from Invention I, Invention III has separate utility from Invention II and Invention III has separate utility from Invention I. This is not found persuasive because of the following:

With respect to the first argument, Applicant asserts that Invention I and Invention II are directed to a network-attachable data storage device, and a method of operating said device respectively, and therefore they are related either as product and process of using or as process and apparatus for its practice. Applicant further cites MPEP §§ 804.05(e) and 804.05(h) to support the assertion that the restriction requirement was set forth in error, however nowhere does Applicant provide "convincing argument that the alternative use suggested by the examiner cannot be accomplished" – see MPEP § 804.05(e). Examiner has met the initial burden of "show[ing], by way of

Art Unit: 2188

example, that one of the subcombinations has utility other than in the disclosed combination per paragraph 005 of the previous restriction requirement" (MPEP § 806.05(d)), therefore Applicant's argument that these two inventions are not subcombinations usable together is not persuasive. Examiner has met his burden by establishing that these inventions are in fact distinct based on their separate usability together in single combination. Additionally, the claimed subject matter of these two inventions further requires a divergent search based on their classification.

Applicant's second augment alleges that separate utility has not been established between the remaining combinations of each invention. This argument however is not persuasive as Examiner's burden with respect to establishing separate utility for subcombinations usable together is a one-way comparison (i.e. Invention I to Invention III or Invention III to Invention I, but not both). Since Examiner has met this burden, and Applicant has failed to provide a substantive retort to Examiner's assertion of separate utility, the argument is not persuasive, and the requirement is still deemed proper, and therefore made FINAL. The previous restriction requirement has been provided below for Applicant's reference.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10, 54-59, 65, and 69 drawn to a network-attachable data storage device utilizing a non-volatile memory and a processor to compare characteristics of stored data content in a memory with reference data content characteristics in order to identify a match, classified in class 711, subclasses 103 and 154.

II. Claims 11-30, 33, 35-37, 52, 53, and 60-64 drawn to a method and a network for storing data content/files based on a set of rules, and subsequently controlling users' access to the memory storing the data content/files, classified in class 711, subclass 163.

III. Claims 31, 32, 34, 38-51, and 66-68 drawn to a server, a data carrier, programmed memory, and network attached storage device utilizing a processor to obtain a fingerprint of a file in a reference library to compare with a reference fingerprint to establish a content related attribute of the file, classified in class 707, subclass 6.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility from invention II, such as in a system using a content-addressable memory to store and retrieve data in the memory based on data content. Invention II has separate utility from invention III, such in a system used to increase network security by monitoring and limiting user access to a memory storing files. Finally, invention I has separate utility from invention III, such as use in a network based database utilizing a reference library of stored signatures to manage a plurality of actions to be taken by the network.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (hence

Art Unit: 2188

resulting in a divergent search), restriction for examination purposes as indicated is proper. See MPEP § 806.05(d).

Priority

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

7. The information disclosure statement (IDS) submitted on 29 January 2004 was fully considered by the examiner.

Drawings

8. The drawings were received on 29 January 2004. These drawings are deemed acceptable for examination.

Specification

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-10, 54-59, 65 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner notes that there are so many issues in these claims, that use of the formal paragraph would be inefficient. Examiner will now address, claim by claim, the issues which render the instant claims vague and indefinite.

As for claim 1, lines 4-5 recited "said data content that is stored in said memory", however data is not previously set forth as being stored in a memory. The non-volatile memory is *for* storing data, however stored data has not been previously claimed. Which data is being referenced here? A similar rejection applies to claim 3, line 3.

As for claim 3, line 3 and line 5 recite "said content", however "said content" is previously set forth within this claim, and "selected said data content" is previously set forth in claim 1. Which data content is being claimed here, the selected or all of the data (presumably which is stored in the memory)? A similar rejection applies to claim 7 in lines 2, 4 and 5 (said data content). Which data content (all or selected) is being claimed here?

As for claim 54, line 8 recites "said consequential action" however a consequential action has not been previously set forth. What action is being referenced here?

Art Unit: 2188

As for claim 56, line 3-4 recited "at least the, or those, or said content-related parameters". Which among the "at least some of said contented-related parameters" per claim 55 are being claimed here? This claim additionally recites "the parameter" lines 4-5. Which among the "at least some of said contented-related parameters" per claim 55 are being claimed here?

As for claim 65, line 7 recites "a said known data content characteristics". Examiner believes Applicant intended to recite "a said known data content characteristic" to match tense within the claim, however this assumption introduces ambiguity into the claim. Which among the characteristics is this said known data content characteristic referring to?

As for claim 69, Examiner is unable to ascertain the metes and bounds of this entire claim, as it is unclear what exactly is being claimed based on the statement in the preamble. More specifically, which statutory category of invention is "in combination" establishing? Is this a claim to a process of combining a memory and a processor, or are the processor and memory being claimed together as an apparatus?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 2188

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-10, 54-59, 65 and 69 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmelzer (US PG Publication 2003/0037010 A1).

As for claims 1 and 69, Schmelzer teaches a network-attachable data storage device, comprising a non-volatile memory for storing data content, a network interface for enabling said device to be connected to a network and a control processor operable to evaluate selected said data content that is stored in said memory to establish whether there is a match between a characteristic of or a derivative of, said selected data content and a reference data content characteristic, or derivative, and to take an action in response to establishment of a said match (referring to Fig. 1, data from a network (i.e. the Internet) is sent to a network appliance (104) via the data flow (102) and evaluated via a content recognizer (102). The data received is identified as a particular content type (i.e. .mp3) and compared to an archive of registered works. If a positive comparison occurs, transmission information is recorded in a content transmission recording device -paragraphs 0033 through 0034, all lines). It is worthy to note that the recognition and comparison servers include a control processor (see paragraph 0048, all lines), the network-attachable data storage device includes a network interface (i.e. the system of Fig. 3 is connected to the Internet), and that the data stream being compared originates from a non-volatile memory (referring again to Fig. 3, data is received from the Internet (for example a peer-peer network – see paragraph 00014, all lines) which uses non-volatile memory (i.e. hard disks, CD-ROMs, etc.) to store sharable media (such as music, video, and photos)).

As for claim 2, Schmelzer teaches said action as including sending information relating to an interaction between an accessing party and content accessed by said accessing party, said processor being adapted to send said information to a party that is not said accessing party (referring again to Fig.3, not only is the information stored in the content transmission recording device as per paragraph 0034, all lines, it also may be forwarded to a client (352) to report back to the owner of the intellectual property as per paragraphs 0068 through 0069, all lines).

As for claim 3, Schmelzer teaches the control processor as being operable to perform at least one of: (i) a sweep of data content stored in said memory in order to evaluate said content, or (ii) to perform an evaluation of content putatively to be added to said memory of the data storage device prior to said content being added to said memory (rather than being limited to network segments of communication for monitoring the data at points of transaction, Schmelzer's system is capable of monitoring uploads and downloads of the data (rather than waiting for the data to be stored at its final destination) as taught in paragraph 0033, all lines).

As for claims 4 and 5, Schmelzer teaches said memory as comprising file-serving memory and further including a content evaluating buffer memory for storing newly received content prior to and whilst newly received content is evaluated (again the memory is the memory used within the peer-sharing network. Schmelzer further teaches buffering the incoming stream into a data buffer which can be used to continuously buffer the data as the stream is being transmitted (Fig. 4, element 212) in paragraph 0051, all lines).

As for claims 6 and 7, Schmelzer teaches a library of data content characteristics or derivatives, wherein said data content characteristics comprise an identity characteristic to identify said-data content as being known, and wherein said identity characteristic is from the group: (i) a signature derived from said data content; (ii) a fingerprint derived from said data content (referring to paragraph 0054, all lines – a database is used to store comparison data which can include a fingerprint or signature (paragraph 0151, all lines)).

As for claim 8, Schmelzer teaches wherein said memory has stored thereon a data content-related parameter correlation, said correlation linking content-related parameters with equivalent known data content characteristics or derivatives, said processor being adapted to use said parameters for determining said action (paragraphs 0033 through 0034, Schmelzer is capable of reading the data from the network and establishes its content characteristics prior to comparison (i.e. file extension type)).

As for claim 9, Schmelzer teaches said parameters as being controllable by a third party via the network (paragraph 0033, all lines – in addition to the element 116 of Fig. 1, the network is connected to a third party (i.e. router) which may be used for content recognition).

As for claim 10, Schmelzer teaches said processor as being configured to enable third party mediated control of said action (monitoring can be performed via multiple network recognition systems and is not limited to a single (i.e. second party) media recognition system – paragraphs 0063 through 0064, all lines).

As for claim 54, Schmelzer teaches a programmed set of rules for determining what is to be said action (if a match occurs, the processor will record the information in the content transmission medium as per paragraph 0034, all lines);

wherein said memory is adapted to store a plurality of data content entities having data content (the memory used by the users of the peer-peer network contain the data content);

wherein content-related parameters are adapted to be available to said processor, said content-related parameters being associated with corresponding data content entities the data being extracted from the memories in the peer-peer network contain file extensions which are extracted by the system (paragraph 0033, all lines); and

wherein said set of rules is adapted to use those of said content-related parameters which relate to a selected data content entity for determining what is to be said consequential action when said selected data content is established as having a characteristic or derivative that matches a known characteristic or derivative (if a match occurs, the processor will record the information in the content transmission medium as per paragraph 0034, all lines).

As for claim 55, Schmelzer further teaches said processor as being programmed for enabling a third party external of said device and connected to said network to set at least some of said content-related parameters (monitoring can be performed via multiple network recognition systems and is not limited to a single (i.e. second party) media recognition system – paragraphs 0063 through 0064, all lines).

As for claim 56, Schmelzer teaches said content-related parameters have an associated content-related parameter control authority (parameter control authority is based off of the file type (i.e. media extension) and said processor is programmed to determine that said third party is authorized to control at least the, or those, of said content-related parameters that said third party sets prior to allowing said third party to set the parameter or parameters (the processor determines that each of the multiple recognition systems (as depicted in Fig. 8) are authorized to control the parameters prior to setting the parameters (i.e. establishing the file type))).

As for claim 57, Schmelzer further teaches a user identity and wherein a data content entity access concordance is adapted to exist, said concordance being arranged for influencing which data content entities in said memory can be accessed by which users, said processor being programmed to use said user-identity and said data content entity access concordance for determining whether or not a user is granted access to a data content entity stored in said memory – (paragraphs 0054 through 0055, all lines, the system can determine if a data stream is authorized based on information related to the user of the data stream).

As for claim 58, Schmelzer teaches a user identity for enabling said processor to identify a user who requests at least one of read and write access to said memory; and wherein said set of rules is adapted to use the user identity as a factor in determining what is to be said action (paragraphs 0054 through 0055, all lines, the system can determine if a data stream is authorized based on information related to the user of the data stream).

As for claim 59, Schmelzer teaches said processor as being arranged so (a) said characteristic of said selected data content is established as matching a known characteristic by processing said selected data content to produce a representative fingerprint or signature and (b) said representative fingerprint or signature is compared with a library of known fingerprints or signatures representative of known data content (referring to paragraph 0054, all lines – a database is used to store comparison data which can include a fingerprint or signature (paragraph 0151, all lines)).

As for claim 65, Schmelzer teaches reference data content characteristic means for having or obtaining reference data content characteristics representative of known data content, and content identifying means for evaluating a selected data content against said reference characteristics from said reference characteristic means for determining whether a characteristic of said selected data content matches a said known data content characteristics (paragraphs 0033 through 0034, all lines – the data can be classified by content type (i.e. file extension), and subsequently compared with stored references); and

said processor being programmed to take a consequential action in response to said content identifying means establishing that a characteristic of said selected data content matches a known characteristic (same line reference, the processor will ensure that the information is recorded in the content transmission recording device).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Price et al. (US Patent 6,986,154 B1) teaches a system and method for selecting content to be presented to a user.

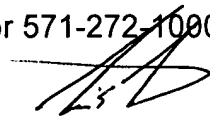
Heymann et al. (US PG Publication 2003/0167299 A1) teaches automatically selecting application services for communicating data.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig E. Walter whose telephone number is (571) 272-8154. The examiner can normally be reached on 8:30a - 5:00p M-F.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 2188

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Craig E Walter
Examiner
Art Unit 2188

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11/15/06